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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,505	07/27/2001	Fabio Cinelli	CM-2016MC	9733

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EXAMINER

LEE, RIP A

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 12/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/917,505

Applicant(s)

CINELLI ET AL.

Examiner

Rip A. Lee

Art Unit

1713

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☒ Claim(s) 2, 10 and 15-18 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-11 and 19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9, 12, 13, and 19 of copending Application No. 09/917,469. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

Present claim 1 is drawn to an adhesive having an initial peel strength (P_I) and a final peel strength (P_F) after exposure to water wherein the ratio of P_I to P_F is from 2:1 to 1:4, and wherein said adhesive has a water absorption capacity of at least 3 % by weight.

Claim 1 of 09/917,469 is drawn to an adhesive having an initial peel strength (P_I) and a final peel strength (P_F) after exposure to water wherein the ratio of P_I to P_F is from 2:1 to 2:4, and wherein said adhesive has a water absorption capacity of at least 3 % by weight.

With respect to the intended use recitation of the parent claim, the current application recites use of adhesive in a disposable human waste management device, and more importantly, the device has a garment facing surface and a wearer facing surface. The wearer facing surface is comprised of the adhesive. The 09/917,469 application recites use of adhesive in a disposable absorbent article. The article also possesses a garment facing surface and a wearer facing surface, and the wearer facing surface is comprised of the adhesive. In this case, a disposable human waste management device qualifies as a disposable absorbent article. As such, the claims are not patentably distinct from each other.

Present claim 2 recites a P_I to P_F ratio of 2:1 .25 to 2:4. Claim 2 of 09/917,469 recites a P_I to P_F ratio of 2:1 .25 to 2:2. As the ranges overlap substantially, the claims are not patentably distinct from each other.

Present claims 3-11 and 19 are faithfully reproduced as claims 3-9, 12, 13, and 19 in application 09/917,469. Therefore, the claims are not patentably distinct from each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: Reference signs ~~32~~, ~~38~~, ~~54~~, ~~68~~, ~~70~~, ~~72~~, ~~78~~, ~~80~~, and ~~82~~, presented in Figure 3, have not been defined in the specification. Furthermore, it is unclear what designations "~~C~~" and "~~D~~" mean. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

4. The current application is a continuation of PCT/US/00/02705 which has been issued as WO 00/45766 A1 to Cinelli *et al.* on August 10, 2000. This information needs to be included on page 1 of the specification. Correction is required. See MPEP § 608.01(b).

Claim Objections

5. Claim 2 is objected to because of the following informalities: Change the ratio "2:4" to the lowest common multiple, "1:2." Appropriate correction is required.
6. Claim 2 is objected to because of the following informalities: The units of *C* have not been provided in the claim, thereby rendering the equations meaningless. Appropriate correction is required.
7. Claim 10 is objected to because of the following informalities: The claim indicates that the adhesive is comprised of polymer. The terms "acrylics," "vinyl alcohols," and "vinyl pyrrolidone" refer to the monomers instead of polymers. Appropriate correction is required.
8. Claims 15-18 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The present claims are drawn to an adhesive. The subject matter of claims 15-18 relates to the article to which the adhesive has been applied rather than to the adhesive itself. As such, the claims fail to limit further the invention of the parent claim.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 1-11 and 13-18 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 98/28014 to Cinelli *et al.*

The prior art of Cinelli *et al.* relates to an adhesive for disposable absorbent articles (claim 1). The adhesive is comprised of 45-99.5 wt % of plasticizer selected from water, alcohols, or glycols, and 0.5-20 wt % of a polymeric compound selected from polyacrylics, polyvinyl alcohols, polyethylene oxides, and polyvinyl pyrrolidones (claims 5 and 6). This satisfies the compositional requirements set forth in present claims 10, 13, and 14. Furthermore, the reference also states that mixed phase compositions are preferred for adhesives of the invention (page 14, line 21). A mixed phase composition is one in which both hydrophobic and hydrophilic components, possibly in both plasticizers and polymers, form two or more separate phases (page 4, lines 8-10). Thus, the subject matter of present claim 11 is taught in the prior art.

The adhesive is characterized by the parameters G''_{25} , G'_{37} , and G''_{37} . The viscous modulus is related to thickness C according to the equation $G''_{25} \leq [(4.26 + C)1605] \text{ Pa}$ (claim 1). Regardless of the value of C , the value of G''_{25} will be less than that imposed in present claims 5 and 6. The adhesive also possesses G'_{37} in the range of 1500-20,000 Pa and G''_{37} in the range of 100-15,000 Pa. These ranges lie squarely within the ranges set forth in present claim 7, and they overlap substantially the ranges set forth in present claims 8 and 9.

The reference is silent with respect to the initial peel strength and final peel strength of the adhesives. Since peel strength is an inherent property of adhesives, and since the prior art material is an adhesive, it follows that the prior art adhesive also possesses peel strength. As such, there is every expectation to believe that this property can be measured according to the

method of the present application. Since the prior art material and that of the present invention have essentially the same composition, as evidenced by their exhibiting essentially the same rheological properties G''_{25} , G'_{37} , and G''_{37} , a reasonable basis exists to believe that they would display essentially the same initial and final peel strength described in present claims 1-4. Since the PTO can not conduct experiments, the burden of proof is shifted to the Applicants to establish an unobviousness difference.

The reference is also silent with respect to the water absorption capacity of the adhesive. However, in view of the fact that the adhesive is essentially the same as that presently claimed (*vide supra*), and in view of the fact that the adhesive is comprised mainly of hydrophilic components, a reasonable basis exists to believe that it displays essentially the same water absorption capacity. Again, the burden of proof is shifted to the Applicants to establish an unobviousness difference. *In re Fitzgerald*, 619 F.2d. 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112-2112.02.

13. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cinelli *et al.* in view of EP 0 850 649 to Coles *et al.*

The discussion of the disclosures of the prior art of Cinelli *et al.* from the previous paragraph of this office action is incorporated here by reference. Although Cinelli *et al.* teaches composition containing both hydrophobic and hydrophilic components, the inventors do not indicate practical working ratios of the two components. Coles *et al.* shows that adhesives containing 30-70 wt % of hydrophilic components and 30-70 wt % of hydrophobic components affords satisfactory adhesives which exhibit properties, G'_{37} , and G''_{37} that meet the requirements

set forth in the present claims. Therefore, one having ordinary skill in the art, having understood the subject matter of the two references, would have found it obvious to use the hydrophilic-hydrophobic ratio taught in Coles *et al.* in order to arrive at present claim 12. One would have found it obvious to combine the teachings because both references teach adhesive compositions containing hydrophilic and hydrophobic components and having the same rheological properties.

14. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cinelli *et al.* in view of WO 96/33683 to Lichstein.

The discussion of the disclosures of the prior art of Cinelli *et al.* from the paragraph 12 of this office action is incorporated here by reference. The inventors do not teach the amount of adhesive to be applied to the wearer facing surface of the disposable absorbent article. Lichstein shows that an adhesive coating weight of 2 mg/cm^2 (claim 12) is suitable for the wearer facing surface of disposable absorbent articles (claims 1 and 2). Thus, it would have been obvious to one having ordinary skill in the art to use a coating weight of 2 mg/cm^2 , as taught by Lichstein, in order to arrive at the claims of the present invention. One would have found it obvious to do so because this amount is adequately disclosed in the reference.

15. The prior art made of record but not relied upon is considered pertinent to the Applicant's disclosure.

U.S. Patent No. 2002/0013565 to Cinelli *et al.*


U.S. Patent No. 2002/0013568 to Cinelli *et al.*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (703)306-0094. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (703)308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703)746-7064. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

ral

November 20, 2002


DAVID W. WU
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